

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Arnold Thaler
Serial No.: 10/829,667
Date Filed: April 22, 2004
Group Art Unit: 3621
Confirmation No.: 6830
Examiner: Kamal, Shahid
Title: **PRODUCT VERIFICATION AND ACTIVATION
SYSTEM, METHOD AND APPARATUS**

MAIL STOP – APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST AND ARGUMENTS

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). At the time of the Final Office Action mailed November 4, 2008, Claims 1-52 were pending in this Application. Claims 1-52 were rejected. No claim amendments are hereby requested. Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicant contends that the rejections of Claims 1-52 on prior art grounds contain clear legal and factual deficiencies, as described below. As of the time of the Final Office Action dated November 4, 2008, Claims 1-7, 9, 12, 14, 15, 19, 20, 41-46, 50, and 52 stood rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2003/0057276 filed by Lawrence Appalucci et al. ("*Appalucci*"), and Claims 8, 10, 11, 13, 16-18, 21-40, 47-49, and 51 stood rejected under 35 U.S.C. § 103(a) as being unpatentable over *Appalucci* in view of U.S. Patent Publication 2004/0205343 filed by Gerald E. Forth et al. ("*Forth*").

Applicant contends that the rejections of Claims 1-52 are not proper for the reasons described in Applicant's Response dated July 25, 2008 at Pages 13-20 ("Applicant's Response"). In short, Applicants contend that, contrary to the Examiner's assertions, the cited references do not teach, either alone or in combination, each and every element of the recited claims.¹

Rejections under 35 U.S.C. § 102

As set forth in Applicant's Response, Applicant respectfully submits that *Appalucci* fails to disclose, either explicitly or inherently "a verification and activation module coupled to the control circuits of the product, wherein the verification and activation module activates the control circuits of the product" as recited in Claim 1, "activating the product with the activation module" as recited in Claim 43, or "communicating with the verification and activation module such that the product is enabled for operation when a correct security code is communication to the verification and activation module" as recited in Claim 50.

With regard to Claim 1, the Examiner attempts to equate the barcode of *Appalucci* to the "control circuits" recited in Claim 1. (Final Office Action, Pages 2-3, 19-20). However, Applicant submits that a barcode cannot be equivalent to a "control circuit." Contemporaneous to Applicant's Response, Applicant submitted an Information Disclosure Statement including the definition of the term "bar code" from the Merriam-Webster Online

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

Dictionary. Merriam-Webster defines “bar code” as a “a code consisting of a group of printed and variously patterned bars and spaces and sometimes numerals that is designed to be scanned and read into computer memory and that contains information (as identification) about the object it labels.” Merriam-Webster Online Dictionary (2008) (retrieved June 30, 2008). Thus, a “bar code” is merely a label that identifies or provides information regarding a product or item. However, in no way could the definition provided above be construed to include a “control circuit” as a bar code, as so defined, is not a “circuit” nor does it provide “control.” Further to this point, Applicant has submitted prior to submission of the Appeal Brief definitions of “control” and “circuit.” From those definitions, it should be abundantly clear that under no reasonable interpretation can “barcode” include a “control” or a “circuit,” let alone a “control circuit.” In fact, the present application explicitly contemplates that a barcode and a control circuit are not and cannot be equivalent. For example, see Figures 3 and 7 and associated specification text. For at least these reasons, *Appalucci* fails to disclose each and every limitation of Claim 1, and thus cannot anticipate Claim 1.

In regard to Claims 43 and 50, Applicant refers to Applicant’s Response at Pages 14-15 in maintaining that, contrary to the Examiner’s assertions, Paragraph [0004] of *Appalucci* does not disclose “entering consumer information,” “programming the product information and consumer information into an activation module,” and “activating the product with the activation module” as recited in Claim 43, and discloses “providing a product having a verification and activation module” and “communicating with the verification and activation module such that the product is enabled for operation when a correct security code is communication to the verification and activation module,” as recited in Claim 50. Due to page-length limitations, Applicant does not repeat these arguments here.

Given that Claims 2-7, 9, 12, 14, 15, 19 and 20 depend from Claim 1 and Claims 44-46 depend from Claim 43, Applicant submits that Claims 2-7, 9, 12, 14, 15, 19, 20, and 44-46 are also allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under § 102(b, e) and full allowance of Claims 1-7, 9, 12, 14, 15, 19, 20, and 43-46.

Applicant notes that in the “Response to Arguments” section of the Final Office Action, the Examiner does not specifically refute any of the arguments made by Applicant in Applicant’s Response, but instead merely restates the Examiner’s original rejections and reasoning therefore (e.g., the Examiner does not provide any guidance as to how a “barcode”

could be equated to a “control circuit,” but merely just restates the Examiner’s position that a “barcode” is a “control circuit,” without any substantive explanation. Accordingly, Applicant submits that the arguments set forth in Applicant’s Response, as supplemented by this paper, are sufficient to overcome the rejections

Rejections under 35 U.S.C. § 103

Although Applicant makes no concessions regarding the rejections of Claims 8, 10, 11, 13, 16-18, and 47, Applicant submits that: (a) 8, 10, 11, 13 and 16-18 are allowable at least because they depend from Claim 1 shown to be allowable above; and (b) Claim 47 is allowable at least because it depends from Claim 43 shown to be allowable above.

In regard to Claims 21 and 33, Applicants again refer to Applicant’s Response at Pages 17-20. As mentioned in Applicant’s Response, contrary to Examiner’s assertions, *Appalucci* does not disclose “a module programmer for programming the verification and activation module, the module programmer is coupled to the point of sale terminal, wherein information from the point of sale terminal is programmed into the verification and activation module so that the product is activated when coupled to the verification and activation module” as recited in Claims 21 and 33.

Given that Claims 22-32 depend from Claim 21, Claims 34-37 depend from Claim 33, and Claim 39 depends from Claim 38, Applicant submits that Claims 22-32, 34-37 and 39 are also allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) and full allowance of Claims 21-40, 47-49, and 51.

Applicant notes that in the “Response to Arguments” section of the Final Office Action, the Examiner does not specifically refute any of the arguments made by Applicant in Applicant’s Response, but instead merely restates the Examiner’s original rejections and reasoning therefore. Accordingly, Applicant submits that the arguments set forth in Applicant’s Response, as supplemented by this paper, are sufficient to overcome the rejections

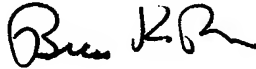
CONCLUSION

Applicant submits these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicant authorizes the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$540.00 for the Notice of Appeal.

Applicant believes there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2684.

Respectfully submitted,
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Date: Dec. 2, 2008

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